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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,461	02/20/2001	Masahiro Nozaki	P 277124 T36-129082M/AIO	5463
909 7590 12/31/2003 PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER STRIMBU, GREGORY J	
			ART UNIT 3634	PAPER NUMBER

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,461

Applicant(s)

NOZAKI, MASAHIRO

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,5 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 01 October 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Election/Restrictions

Applicant's election with traverse of restriction requirement in Paper No. 4 is acknowledged. The traversal is on the ground(s) that subject matter of all of the species is sufficiently related that a thorough search for the subject matter of any one species would necessarily encompass a search for the remaining species. This is not found persuasive because the allegations listed above show that the applicant has not analyzed the examiner's action in the context of the established practice for requiring an election of species as set forth in chapter 800 of the MPEP. It is a well established practice that a requirement to elect a single species is a holding by the examiner that the plural species, as claimed, are patentably distinct (i.e., capable of supporting separate patents). See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, the applicant need merely clearly state on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the species that are not patentably distinct are obvious in view of one another. Applicant's response implies that the various species are not considered to be patentably distinct. If this is the case, then the applicant must clearly admit such on the record. The requirement is still deemed proper and is therefore made FINAL.

Claims 6 and 7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 2, 2002 and October 1, 2003 have been approved.

The drawings are objected to because the same reference characters have been used to describe both the prior art in figures 11 and 12 and the invention. For example, reference character 17 has been used to represent the door sash in both figure 11 and figure 1. Because the door sashes 17 are different for each figure, the figures require different reference characters. It is suggested that the applicant change the reference characters in figures 11 and 12. For example, it is suggested that the applicant change reference character "17" in figure 11 to --17'-- and reference character "15" in figure 12 to --15'--. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claims 2, 4, 5 and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "according comprising" on lines 1-2 of claim 11 are confusing since it is unclear what the applicant is attempting to set forth. Recitations such as "said attachment groove" on lines 7-8 of claim 11, "the window glass" on line 21 of claim 11, and "the interior of the vehicle" on line 2 of claim 5 render the claims indefinite because

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they lack antecedent basis. Recitations such as "exterior side" on line 12 of claim 11 render the claims indefinite because it is unclear what element of the invention includes the side to which the applicant is referring. Recitations such as "a lock protrusion strip" on line 13 of claim 11 render the claims indefinite because it is unclear if the applicant is referring to the lock protrusion strip set forth above or is attempting to set forth another lock protrusion strip in addition to the one set forth above. Recitations such as "a wall" on line 13 of claim 11 and "a window glass" on line 23 of claim 11 have the same problem. Recitations such as "U-shaped section" on line 16 of claim 11 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the applicant only describing a portion of the trim or is the applicant setting forth that the trim has a U-shaped cross section? Recitations such as "formed separately from said trim" on line 18 of claim 11 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the applicant setting forth a method step or is the applicant setting forth that the trim and the glass run are separate elements of the invention? Recitations such as "a surface of the trim" on line 2 of claim 2 render the claims indefinite because it is unclear if the surface of the trim comprises the part of the trim in contact with the glass run as set forth on line 25 of claim 11 or if the surface of the trim is in addition to the part of the trim set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 5 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in figure 11 and Vaughan et al.

The admitted prior art in figure 11 discloses a trim and glass run attachment structure in a vehicle door comprising, a flange part (not numbered, but seen in figure 11) provided on a window frame 13 of the vehicle door, wherein the window frame is comprised by an inner panel 15, an outer panel 16 and a door sash 17, and the flange part is comprised by a portion of the window frame at which an interior flange 15b of the inner panel and an interior flange 17a of the door sash are joined together and to which a trim 31 is mounted, and wherein a lock protrusion strip 17d is provided on a wall of the attachment groove 17c that is on a door interior side of the attachment groove and at a proximal end of the flange part, a U-shaped attachment groove 17c, which is adjacent to and integral with the proximal end of the flange part, wherein the U-shaped attachment groove is on a door exterior side and an outer peripheral side of the proximal end of the flange part, a lock protrusion strip 17d provided on a wall of the attachment groove that is on a door interior side of the attachment groove, and the lock protrusion strip is at the proximal end of the flange part, and a glass run 31a, wherein the glass run has a glass run body (not specifically numbered, but shown in figure 11) attached to the attachment groove, wherein the glass run body includes opposing side walls (not numbered, but shown in figure 11) and a pair of seal lips 31b and 31c, one seal lip 31b of the pair of seal lips being on the door interior side of the window glass and one seal lip 31c of the

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pair of seal lips being on the door exterior side of the window glass, and wherein the seal lips are structured to engage opposing sides of a window glass 14, and wherein the glass run body has a lock protrusion strip (not numbered, but shown in figure 11) engaging with the lock protrusion strip of the attachment groove to retain the glass run body in the groove, and a door exterior part of the flange part and a door interior part of the attachment groove are integrally formed as a single component, and wherein the flange part and attachment groove are formed in series and are portioned by the lock protrusion strip of the attachment groove. The admitted prior art of figure 11 is silent concerning a glass run formed separately from the trim.

However, Vaughan et al. discloses a trim and glass run attachment structure comprising a trim (not numbered, but shown in figure 3) formed separately from a glass run 26 wherein a part of the trim (not numbered, but seen in figure 3) is in contact with part 126 of the glass run when the trim is attached to a flange part 60.

It would have been obvious to one of ordinary skill in the art to provide the admitted prior art of figure 1 with a trim formed separately from the glass run, as taught by Vaughan et al., to reduce the cost of manufacturing the trim and glass run attachment structure.

Response to Arguments

Applicant's arguments filed October 1, 2003 have been fully considered but they are moot in view of the new grounds of rejection.

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Conclusion

THIS ACTION IS NOT MADE FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



Gregory J. Strimbu
Primary Examiner
Art Unit 3634
December 15, 2003